

REMARKS

Claim Rejections - 35 USC §103

Claims 1-8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hauser et al. (U.S. Patent NO. 6,536,659 B1, hereinafter "Hauser") in view of Yu (U.S. Patent No. 2002/0120535 A1, hereinafter "Yu").

Regarding claim 1, Applicants respectfully traverse the rejections since the Applicants' claimed combination, as exemplified in claim 1, includes the limitation not disclosed in Hauser or Yu of:

- "(7) determining via the return product processing station if the repaired but not properly operating return product is to be disassembled for obtaining useful assemblies therein, wherein if the return product is to be disassembled, then step (8) is followed; or else, step (9) is followed;
- (8) constructing a material stock file via the system for processing a return product according to the disassembled useful assemblies of the return product, and re-assembling the useful assemblies to semi-fabricated products in production via the production line after reading the material stock file; and
- (9) constructing a testing product lacking assembly file via the system for processing a return product according to useless assemblies of the repaired but not properly operating return product, and replacing the useless assemblies of the return product with useful assemblies for making the return product be an exporting product via the production line after reading the testing product lacking assembly file."

The Examiner states:

"Hauser does not explicitly disclose repairing products not functioning properly but Yu discloses a repair execution system (RES) connected to the return material authorization (RMA) processor for administering and tracking a repair activity (process) of the returned product according to repair data provided by the repair center (see abstract)."

Applicants agree with what Hauser does not disclose. However, the Examiner has not indicated where claimed steps 7, 8, and 9 are taught or suggested in Yu. It is respectfully submitted that 37 CFR §1.104(c)(2) specifies:

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as

practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”[underlining for clarity]

It is respectfully requested that the Examiner provide the particular parts of Yu by paragraph number that are being relied upon.

To move prosecution forward, Applicants respectfully submit that Yu discloses a website system for providing on-line data-exchange. Yu has taught repairing the return product not functioning properly, but fails to teach claimed steps 7-9, and more particularly the limitations of "re-assembling the useful assemblies disassembled from the return product to semi-fabricated products" or "replacing the unuseful assemblies of the return product with useful assemblies for making the return product be an exporting product".

Since neither Hauser nor Yu discloses, teaches, or suggests the claimed limitations of the Applicants' claimed method including "re-assembling the useful assemblies disassembled from the return product to semi-fabricated products" or "replacing the unuseful assemblies of the return product with useful assemblies for making the return product be an exporting product", the Examiner's alleged combination cannot render the method of the present invention obvious.

Based on the above, it is respectfully submitted that claim 1 is allowable under 35 U.S.C. §103(a) as being patentable over Hauser in view of Yu because:

“[T]he prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” [bold for clarity] *In re Vaeck*, 947 F2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)

Regarding claims 2-8, these dependent claims respectively depend from independent claim 1 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations.

Based on the above, it is respectfully submitted that claims 1-8 are allowable under 35 U.S.C. §103(a) as being patentable over Hauser in view of Yu because of the holding in *In re Vaeck*, *supra*.

Response to Arguments

The Examiner stated that Applicants' arguments filed November 9, 2005 have been fully considered but they are not persuasive:

"Applicant argues that Hauser does not disclose "repairing products not functioning properly," Contrary to Applicant's arguments, the newly cited reference (Yu) is used to disclose such element of the claim. As a result, claims 1-8 remain rejected."

It is respectfully submitted that the Examiner adopted Applicants' arguments and cited but did not apply the Yu reference. Application of the Yu reference is requested above. However, to move prosecution forward, an explanation of the shortcomings of Yu have respectfully been provided. As explained above, it is respectfully submitted that claims 1-8 are allowable under 35 U.S.C. §103(a) as being patentable over Hauser in view of Yu

Conclusion

In view of the above, it is submitted that the claims are in condition for allowance and reconsideration of the rejections is respectfully requested. Allowance of claims 1-8 at an early date is solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including any extension of time fees, to Deposit Account No. 50-0374 and please credit any excess fees to such deposit account.

Respectfully submitted,



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Date: May 24, 2006